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AUG 15 2007

Serial No. 10/696,921

Response to Office Action

Mailed May 15, 2007

IN THE DRAWINGS

Please replace Page 1 of the figures with the Replacement Page enclosed herewith.

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REMARKS

The Applicant is filing this Amendment and Response in response to an Official Action dated May 15, 2007. At the time of the Official Action, claims 1-10, 12-26 and 28-33 were pending. In this Response and Amendment, no claims are canceled or added. Accordingly, claims 1-10, 12-26 and 28-33 remain currently pending. Claim 19 is amended herein.

In the Office Action, the Examiner objected to the drawings as being mislabeled. Further, in the Office Action, claims 19-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-10, 12-26 and 28-33 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,901,397 to Moldenhauer et al. (“the Moldenhauer reference”). The objection and each of the rejections is addressed in detail below.

Objection To The Drawings

The Applicant has corrected FIG. 1, in accordance with the remarks set forth by the Examiner. Withdrawal of the objection to the drawing is respectfully requested.

The Rejection Under 35 U.S.C. § 101

With respect to the Examiner rejection of claims 19-25 under Section 101 as being directed to non-statutory subject matter, the Examiner stated:

Claims 19-25 define a “system” comprising “a plurality of device information files” and “means for providing an on-screen display”. In light of the specification, these components are broad enough to encompass computer data (“files”) and disembodied computer software (“means for

Serial No. 10/696,921
Response to Office Action
Mailed May 15, 2007

providing [a] display"). These claims therefore encompass functional descriptive material ("means for") and nonfunctional descriptive material ("files") absent any tangible embodiment. These claims are nonstatutory. Additional explanation is found in MPEP 2106.01.

Office Action, page 4.

Legal Precedent

According to the Supreme Court, congress intended statutory subject matter to "include anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09; 206 U.S.P.Q. 193, 197 (1980). Indeed, exclusions of statutory subject matter are limited to laws of nature, natural phenomena and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185; 209 U.S.P.Q. 1, 7 (1981). Other than these specific exceptions, therefore, nearly anything man made is statutorily patentable subject matter under 35 U.S.C. §101.

In determining when process or method claims include statutory subject matter, the Supreme Court in *Diehr* stated that "[t]ransformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines." *See id.* 450 U.S. at 183-185, 209 U.S.P.Q. at 6. In addition to the Supreme Court's transformation and reduction test, the Federal Circuit has developed a second test which may also be used to determine if a claim recites statutory subject matter, namely does the claim produce a "useful, concrete, and tangible result." *In re Alappat*, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994) (*en banc*). The Federal Circuit further elaborated on this second test by holding that one must look to "the essential characteristics of the subject matter, in particular, its practical utility." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998).

Serial No. 10/696,921
Response to Office Action
Mailed May 15, 2007

However, explaining this “useful, concrete, and tangible” test, the Federal Circuit has stated “the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter.” *In re Alappat*, 31 U.S.P.Q.2d at 1557. Indeed, there has been no requirement from Congress, the Supreme Court, or the Federal Circuit mandating that a *specific final result* be shown for a claim to qualify under Section 101. *See id.* Rather, the Federal Circuit has specifically stated “the *Alappat* inquiry simply requires an examination of the contested claims to see if the claimed subject matter *as a whole* is a disembodied mathematical concept representing nothing more than a ‘law of nature’ or an ‘abstract idea,’ or if the mathematical concept has been reduced to *some practical application rendering it ‘useful’*.” *AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1451 (Fed. Cir. 1999) (emphasis added). Therefore, if a claim meets either the transformation and reduction test put forth by the Supreme Court, or if the claim, read as a whole and in light of the specification, produces any useful, concrete, and tangible result, the claim meets the statutory requirements of Section 101. *See id.*

Applicant respectfully asserts that claims 19-25, taken as a whole, each recite statutory subject matter under 35 U.S.C. §101 because they produce a useful, concrete and tangible result. The present application is directed to methods and systems employed by call centers for assisting customers and minimizing costs related to returned devices. Particularly, the present application addresses problems that arise when:

the customer is unable to effectively communicate the status of a device or explain the specific difficulty that is being experienced to the call center support person. In many cases, the call center support person, while knowledgeable, does not have access to a device that is just like the customer’s device. This problem may be compounded if the company sells many devices that require

Serial No. 10/696,921
Response to Office Action
Mailed May 15, 2007

different set-up procedures. It may be impossible for call center employees to be familiar with each and every device sold by their company, as well as the set-up procedures for each device. Call center employees may not be able to help their customers because the call center employee may not be able to duplicate the difficulty the customer is experiencing. If the call center employee is not able to help the customer set up their device, the customer may return the device for a refund even though the device may not be broken or defective.

Application, paragraph 5.

For example, independent claim 19 recites a system comprising "means for providing an *on-screen display ("OSD") emulation* for the at least one device whose emulation information is contained in a selected one of the plurality of device information files." (Emphasis added.) Claim 19, therefore, taken as a whole, recites an on screen display emulation employed by remote employees, such as call center operators and the like, to reproduce a visual display or other feedback that a customer sees or otherwise receives when the customer is trying to set up a newly purchased device, such as a computer system or computer monitor. An OSD system in accordance with embodiments of the present invention may allow the call center operator to provide effective feedback to customers regarding a large number of devices. This is clearly a useful, concrete and tangible result which addresses the above mentioned shortcomings of existing customer support call centers.

In addition, claim 19 has been amended to recite "a plurality of device information files stored on a tangible machine-readable medium..." (Emphasis added). The Commissioner of Patents has recognized the patentability of software, provided that it is embodied in a tangible medium. Indeed, the Commissioner has directly stated that, "computer programs embodied in a tangible medium...are patentable subject matter under 35

Serial No. 10/696,921
Response to Office Action
Mailed May 15, 2007

U.S.C. §101." See *In re Beauregard*, 53 F.3d 1583 (Fed Cir. 1995). For at least these reasons, Applicant respectfully requests withdrawal of the rejection of claims 19-25 under Section 101.

The Rejection Under 35 U.S.C. § 102(e)

With respect to the rejection of independent claims 1, 10, 19 and 26 under Section 102 based on the Moldenhauer reference, the Examiner stated:

A system comprising a plurality of device information files that each contain emulation information about a different device ["The present invention is a web-based application that assists customer service and sales representatives when dealing with customers by phone... It includes detailed information regarding each type of DSS receiver." (column 2, lines 9-24)]; and

An emulator that is adapted to read a selected one of the plurality of device information files and provide an on-screen display ("OSD") emulation having characteristics of a visual display associated with the device based on the emulation information contained in the selected one of the plurality of device information files ["When the rep selects a model of DSS receiver on the tool's graphical user interface (GUI), he can rotate it to see the wiring ports on the back of the specific model. If a remote control is being discussed with a customer, the rep can click on any button on the representation of the remote and a dialog box will appear with predetermined text for the rep to use in discussing the problem with the customer. The image of a specific piece of equipment is active; i.e. if an actual DSS receiver has a red light that can blink, so does the display viewed by the rep." (column 2, lines 25-50)].

Office Action, pp. 2-4.

The Applicant respectfully traverses the rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to

Serial No. 10/696,921
Response to Office Action
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anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

In the present case, the Moldenhauer reference does not anticipate the Applicant's claims under Section 102 because every element of the claimed invention is not identically shown in the Moldenhauer reference. Specifically, independent claim 1 recites a computer system having a plurality of device information files and “an *emulator* that is adapted to read a selected one of the plurality of device information files and provide an on-screen display (“OSD”) *emulation of the at least one device.*” (Emphasis added). Similarly, independent claim 10 recites “invoking an *emulator* that is adapted to access the plurality of device information files and provide an on-screen display (“OSD”) *emulation* that is based on the emulation information *for the at least one device.*” (Emphasis added). Independent claim 19 recites a system having a plurality of device information files that contain emulation information about at least one device, and means for “providing an on-screen display (“OSD”) *emulation of the at least one device.*” (Emphasis added). Independent claim 26 recites similar subject matter. Hence, the present claims are directed towards on-screen

Serial No. 10/696,921
Response to Office Action
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display (OSD) emulation employed by remote employees for providing customers on purchased devices. The term "emulation," as recited by the claims should be construed herein as providing an on-screen display similar in appearance to what the customer sees when attempting to set up the device. *See, Application, paragraph 23.* In this manner, the call center employee may guide the customer through the set-up process and assist the customer in addressing problems and difficulties that may arise with the purchased device.

In contrast, the Moldenhauer reference discloses a system configured to

assist the representatives fielding calls regarding satellite systems, such as direct satellite service (DSS) receivers. The software tool allows the representative to screen a customer for serviceability, direct him to the nearest retail location, answer regional sports availability, tailor an order to a customer's needs by simply asking a series of questions.

Moldenhauer, col. 2, lines 12-18.

As clearly shown by the above quote, the Moldenhauer reference, at best, discloses software adapted to provide a user with several options with several options of services to choose from. According to Moldenhauer, customer service representatives or customers may access these options, via a home page, so as to resolve customer support issues pertaining to the aforementioned services. *See also, Moldenhauer, col. 5, line 44-col. 6, line 30.* However, there is no disclosure in Moldenhauer of customer support systems adapted to emulate purchased devices. That is, the cited reference clearly does not disclose an emulator adapted to provide an on-screen display similar in appearance to what the customer sees when attempting to set up the device. Therefore, the Moldenhauer reference does not disclose or suggest an emulator that is adapted to read a selected one of the plurality of device

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Serial No. 10/696,921
Response to Office Action
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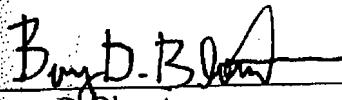
information files and provide an on-screen display (OSD) emulation of the at least one device, as recited by independent claim 1, and as similarly recited by independent claims 10, 19 and 26.

For at least these reasons, the Applicant respectfully submits that independent claims 1, 10, 19 and 26 (and the claims dependent thereon) are not anticipated by the Moldenhauer reference. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claims 1-10, 12-26 and 28-33 under Section 102 based on Moldenhauer reference.

Conclusion

In view of the remarks set forth above, the Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims 1-10, 12-26 and 28-33. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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